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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,262	07/20/1999	MASATOSHI SASE	450100-4995	8998

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EXAMINER

TRAN, NHAN T

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/357,262

Applicant(s)

SASE ET AL.

Examiner

Nhan T. Tran

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 July 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 3, 4 and 6, 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4 & 5 of copending Application No. 09,358,160. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claims 1, 3, 4 and 6, 8 is encompassed by claims 1, 4 & 5 of the Application No. '160.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4-8 & 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hieda (US 6,377,301).

Regarding claim 1, Hieda discloses a video camera apparatus comprising:

A solid image sensor (CCD 1) for outputting an image sensing signal in an interlaced scan mode (moving-image mode) or a progressive scan mode (still-image mode or all pixels ) (see figs. 1, 2(a)-(b) & 3(b), abstract & col. 2, lines 9-13, 20-47; col. 4, lines 8-16; col. 5, lines 49-60);

image sensing signal processing means (11) supplied with the image sensing signal from the solid image sensor (see fig. 1; col. 3, lines 60-63);

scan converter means (12) supplied with the image sensing signal from the image sensing signal processing means (11), for converting the image sensing signal read out from the solid

image sensor in the progressive scan mode (still-image mode), into an interlaced scan signal (see fig. 1; col. 3, lines 63-65; col. 5, lines 4-8);

control means (16, 17) for performing control of switching an input (at switch 13) to recording means (15), in correspondence with an operation mode of the solid image sensor (see fig. 1; col. 4, lines 8-19 & col. 5, lines 4-13);

the recording means (15) for recording the image sensing signal read out from the solid image sensor in the interlace scan mode (moving-image mode), directly onto a recording medium, and for converting the image sensing signal read out from the solid state image sensor in the progressive mode (still-image mode), into an interlace scan signal, by the scan converter means (12), and then recording the interlace signal onto the recording medium (see fig. 1; col. 5, lines 4-13).

Regarding claim 2, Hieda also discloses switching means (16, 13, 7, 3) for performing switching between still image recording and motion image recording (see fig. 1; col. 4, lines 8-19; col. 5, lines 4-13).

Regarding claim 4, Hieda's video camera system also comprises switching means (16, 13, 7, 3) for switching the operation mode of the solid image sensor to the progressive scan mode (still-image mode) and the interlace scan mode (moving-image mode) (see figs. 1 – 3(b); col. 4, lines 8-19 & col. 5, line 49 – col. 6, line 67).

Regarding claim 5, the switching means for switching the operation mode of the solid image sensor to the progressive scan mode, when the still image recording is performed (see col. 5, lines 4-8).

Regarding claim 6, the claimed limitations are analyzed with respect to claim 1.

Regarding claim 7, the claimed limitations are analyzed with respect to claim 2.

Regarding claim 8, the claimed limitations are analyzed with respect to claim 5.

Regarding claim 10, Hieda discloses a step of switching an operation mode of the solid image sensor to the progressive scan mode and the interlace scan mode when the recording medium is a magnetic recording medium (VCR tape 15) (see fig. 1; col. 5, lines 4-13).

***Claim Rejections - 35 USC § 103***

3. Claims 3 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hieda (US 6,377,301) in view of Parulski et al (US 5,440,343).

Regarding claims 3 & 9, Hieda discloses means for switching a reading mode of the solid image sensor to a progressive scan mode (still-image mode) and records the image into the magnetic tape (15) as analyzed in claims 1 & 2. Hieda does not disclose that the recording

medium is a memory card for recording an image in the still-image mode. However, Parulski suggests a method for recording the imaging signal in "motion" mode and "still" mode. In "motion" mode, the recording device is preferably a magnetic tape, and in "still" mode, the recording device is preferably a digital memory card (for example, Flash EPROM memory card) (see col. 3, lines 16-36).

It would provide the Hieda's recording device a recording medium of high quality level and more compatibility with various digital reproduction systems by utilizing the memory card for still image recording in the progressive scan mode, and such method is also preferred for still image recording as suggested by Parulski.

Therefore, it would have been obvious to one of ordinary skill in the art to use the teaching of Parulski to combine with Hieda's camera system for recording still images on a memory card in the progressive scan mode or still-image mode.

### *Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhan T. Tran whose telephone number is (703) 605-4246. The examiner can normally be reached on Monday - Friday, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

NT.  
March 14, 2003

  
NGOC-YEN VU  
PRIMARY EXAMINER